

## **DETAILED ACTION**

### ***Response to Remarks/Arguments***

1. This communication is considered fully responsive to the Amendment filed on 04 February 2011.

2. Applicant's arguments have been fully considered and are persuasive.

The 35 USC § 103 rejections to claims 1, 4-7, 10-13 and 16-18 are therefore withdrawn.

### **Reasons for Allowance**

3. The following is an examiner's statement of reasons for allowance: After a comprehensive and reasonable search of the prior art no reference or obvious combinations of references could be found covering the subject matter of amended claim(s) 1, 7 and 13. The prior art alone or in combination fail to teach or make obvious the following when considered in combination with other limitations in the claim: "*second IP communication means for transmitting/receiving image data to/from the destination station based on the facsimile protocol by said facsimile communication means, and transmitting/receiving the VoIP data obtained through said converting means to/from a gateway of the destination station, in accordance with a discrimination result that the destination station is not able to transmit/receive communication data on the IP network based on the predetermined file transmit/receive protocol independent of the facsimile protocol, wherein the VoIP data is transmitted/received via the IP network connecting means without via a line switching network, using the obtained IP*

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address of the destination station." as in amended claim 1 and similarly amended claim(s) 7 and 13. Also, when the destination is not able to use the predetermined file protocol independent of the facsimile protocol, the second IP communication means transmits/receives image data based on the facsimile protocol using the VoIP data. In this case, since the VoIP data (including a telephone number data) is transmitted/received to/from a gateway of the destination using the IP address of the destination station, it is not required to redial the destination via a public line so as to change over to the facsimile communication. Further, since the gateway of the destination is merely required to convert the VoIP data to a signal having a band used for a voice call and not required to read a facsimile protocol, a configuration of the gateway can be simplified.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Determining whether the claim falls within one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. 101 (i.e., process, machine, manufacture, or composition of matter) does not end the analysis because claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection. *Diehr*, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197;

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*Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); *Benson*, 409 U.S. at 67-68, 175 USPQ at 675; *Funk*, 333 U.S. at 130, 76 USPQ at 281.

5. **Claim(s) 13 and 16-18** is/are directed towards transitory propagating signals. A broad but reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and also transitory propagating signals in view of the ordinary and customary meaning of computer readable media. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments *may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claim.* Cf *Animals - Patentability*, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987) (suggesting that applicants add the limitation “non-human” to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal is the only

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viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. *See, e.g., Gentry Gallery, Inc. v. Berkline Corp.*, 134F.3d 1473 (Fed. Cir. 1998).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN LEE whose telephone number is (571)270-5606. The examiner can normally be reached on 9/4/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. L./

Examiner, Art Unit 2445

/Andrew Caldwell/

Supervisory Patent Examiner, Art Unit 2445